

Appl. No. 10/767,599
Amdt. dated 07/24/2006
Reply to Office action dated: Dec 9, 2005 Mailed: Jan 12, 2006

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. (emphasis added)

While all three of the cited references involve illumination on, around or of a flat surface, there is no teaching, suggestion or motivation in the identified prior art to combine the two or more of the patents as required under 103(a). The problem being solved by the Watson is to illuminate a street sign. The problem being solved by Yu is to illuminate a license plate. The problem being solved by Sanders is to illuminate a house address. They each provide solutions to their problems, but there is no motivation explicitly or implicitly to combine these reference as taught within these references that is sufficient to

Words does not equate to a finding of obviousness. "[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the inventions as a whole for which patentability is claimed." *Hartness*

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International, Inc. v. Simplimatic Engineering Co., 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1832 (Fed. Cir. 1987).

Moreover, even patentable claims are made up of known elements. "That all elements of an invention may have been old is not unusual, and indeed, irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements." *American Medical Systems Inc. v. Medical Engineering Corp.*, 6 F.3d 1523, 28 USPQ2d 1321 (Fed. Cir. 1993).

The prior art must suggest the desirability to combine. "[T]he questions is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would 'suggest the desirability', and thus the obviousness, of making the combination." *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1498, 1 USPQ2d 1337, 1343 (Fed. Cir. 1986). In short, there is no suggestion that would lead one to combine the references and limitations as identified by the examiner.

It is noted by the applicant that PAIR indicates that the claim amendments from the last reply dated and received by the USPTO on 02-09-2006 have not entered. This was determined by the applicant when viewing the image file wrapper in PAIR. There is no explanation in PAIR regarding this action and the final office action from the examiner is mute in regards to this action yet a final office action has been issued. Based upon the lack of entry of the last amendments and the lack of notification regarding this action, the applicant feels that the final rejection should be withdrawn until a proper evaluation of the last reply has been made.

In the last office action the examiner failed to address added claims 23-26, and the applicant clarification regarding the patentability of these claims.

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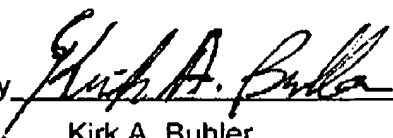
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Claims 2-4, 6, 7, 11-14, 16, 18-20, 22-26 are not obvious based upon the changes made to independent claims 1, 8, 15 and by virtue of their dependence on independent claims 1 8, and 15.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BUHLER & ASSOCIATES

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